

### **REMARKS**

Claims 6-16 and 47-78 are pending in the current application. Claims 6-16, 47, 48, 53, 62-65, 75 and 76 have been allowed. Claims 50, 51, 60, 61, 66-69, 74, 77 and 78 have been amended. Claims 49, 52, 54-59 and 70-73 have been canceled without prejudice. Applicants reserve the right to pursue these claims in a related application. Upon entry of these amendments, claims 6-16, 47, 48, 50, 51, 53, 60-69 and 74-78 will be pending. Support in the specification for amended claims may be found in the specification as shown in the following table:

<u>Claim</u>	<u>Support in specification</u>
60	Page 17, lines 5-28; page 16 line 20 to page 17, line 4
61	Page 17, lines 5-28; page 16 line 20 to page 17, line 4
66	Page 15, lines 21-27;
67	Page 15, lines 21-27;
68	Page 15, line 27 to page 16, line 2;
69	Page 15, line 27 to page 16, line 2;
74	Page 16, lines 11-12; page 17, lines 5-19;
77	Page 16, lines 11-12; page 15, line 21 to page 16, line 2;
78	Page 16, lines 11-12; page 15, line 21 to page 16, line 2.

As set forth above, these claim amendments are supported by the specification, and no new matter has been introduced.

Claim 50 has been amended to more distinctly point out the subject matter of the Applicants' invention. Specifically, claim 50 has been reworded to provide an antecedent basis for the limitation "the oncogene." Claim 51 has been amended to be consistent with the wording of claim 50, upon which it depends. Claims 60, 61 and 74 have been amended to include a step of determining the level or activity of the recited protein. Claims 66-69, 77 and 78 have been amended to include a step of determining the number of cells that die under the assay conditions recited therein. Finally, claim 66 has been additionally amended to provide antecedent basis for the limitation "said plurality of cells."

Entry of the foregoing amendments and remarks into the file of the above-referenced patent application is respectfully requested. Applicants believe that each ground for rejection

has been successfully overcome or obviated. Reconsideration of the present application in view of the following remarks is respectfully requested. For the reasons stated above, Applicants believe that the claims are now in condition for allowance.

**Rejections Under 35 U.S.C. § 112, First Paragraph**

The Examiner has rejected claims 49, 52, 54-59 and 70-73 under 35 U.S.C. § 112, first paragraph, for lack of enablement for the reasons advanced on pages 2-4 of Paper No. 19 (“Paper No. 19”) and on pages 2-4 of Paper No. 34. Applicants have canceled these claims, without prejudice, and reserve the right to pursue these claims in a related application. Because Applicants have canceled these claims, the Examiner’s rejection of these claims on this ground is moot.

**Rejections Under 35 U.S.C. § 112, Second Paragraph**

The Examiner has rejected claims 50-52, 60, 61, 66-69, 74, 77 and 78 under 35 U.S.C. § 112, second paragraph as indefinite “for reasons of record advanced on pages 5-7 of the Office Action of Paper No. 19 . . . and on pages 4-5 of the Office Action of Paper No. 34 . . .” Office Action at page 4. Claims 50-52, 60, 61 66-69, 74, 77 and 78 as herein amended should now be in condition for allowance.

The Examiner contends that claims 50-52 are indefinite because the limitation “the oncogene” in claim 50, line 2 has no antecedent basis. Applicants have rewritten claim 50 to provide such antecedent basis. Additionally, claim 50 was not rejected under 35 U.S.C. § 112, second paragraph in either Paper No. 19 or Paper No. 34, and none of the rejections recited therein apply to claim 50 as currently amended. Applicants therefore respectfully request the Examiner withdraw the rejection of this claim on this basis. As claim 51 depends from claim 50, the rejection of this claim on this basis should be withdrawn, as well. Claim 52 has been canceled; therefore, the rejection of this claim is moot.

The Examiner also contends that claims 60, 61 and 74 are “indefinite in their recitation of ‘comparing the level or activity of said protein in the presence of said agent with the level or activity of said protein in the absence of said agent’ because no measurements have been taken to determine the level or activity of any protein in either the presence or absence of the candidate agent.” Office Action at page 4. While Applicants disagree that the claims as pending are indefinite, Applicants have amended claims 60, 61 and 74 to include such a determination step. The indefiniteness rejections of Paper Nos. 19 and 34 are not

relevant to claims 60, 61 or 74 as currently amended. In Paper No. 19 and Paper No. 34, these claims were rejected for recitation of “measuring the ability of the candidate agent to modulate the activity of a protein produced by the cell” because it was not clear what type of measurement being referred to. This phrase is not present in amended claims 60, 61 or 74. (Paper No. 19 did not contain a rejection of claim 74 on this basis.) Moreover, these claims as amended specifically recite that what is measured is the level or activity of the recited protein. Applicants therefore submit that these claims as amended are definite, and request withdrawal of the rejections of claims 60, 61 and 74, as stated in Paper Nos. 19 and 34 and in the present Office Action, on this basis.

The Examiner also contends that claim 66 is indefinite in its recitation of “said plurality of cells” because the phrase lacks antecedent basis. Applicants have amended claim 66 to provide antecedent basis for this phrase, and request the Examiner withdraw this rejection of claim 66 on this basis.

The Examiner also contends that claims 66, 67 and 77 are “indefinite in their recitation of ‘subsequently comparing the number of said plurality of cells that die in the presence of said agent to the number of said plurality of cells that die in the absence of said agent’ because no measurements have been taken to determine the number of cells that die in either the presence or absence of an agent.” Office Action at page 4. While Applicants disagree that the claims as pending are indefinite, Applicants have amended claims 66, 67 and 77 to include such a determination step.

The indefiniteness rejection of Paper Nos. 19 and 34 are not relevant to claims 66, 67 or 77 as pending or as currently amended. In Paper Nos. 19, the Examiner contended claims 66 and 67 were “indefinite in their recitation of ‘measuring the ability of the candidate agent to affect death of the cell’ because it is unclear what type of measurement is being referred to.” Paper No. 19 at page 7. Similarly, in Paper No. 34, the Examiner contended claims 66 and 67 were “indefinite in their recitation of ‘measuring the ability of the candidate agent to affect death of the cell by measuring cell death’ because it is unclear what type of measurements are to be made to measure cell death.” Paper No. 34 at page 5. The phrases quoted above by the Examiner are not present in the claims as amended. The Examiner also contended that it was “unclear how the recited measurement correlated with ‘identifying an agent that affects dorsal root ganglion cell death.’” Paper No. 19, page 7; Paper No. 34,

pages 4-5. As amended, the claims explicitly correlate the amount of cell death (*i.e.*, the number of cells that die) with the identification of the agent. Applicants therefore respectfully submit that these claims as amended are definite, and request withdrawal of the rejections of claims 66, 67 and 74, as stated in Paper Nos. 19 and 34 and in the present Office Action, on this basis.

Finally, the Examiner contends that claims 68, 69 and 78 are “indefinite in their recitation of ‘comparing the number of said plurality of cells that die when said level of expression is altered to the number of said plurality of cells that die when said level of expression is not altered’ because no measurements have been taken to determine the number of cells that die when the level of expression of a protein is either altered or not altered.” Office Action at page 5. While Applicants disagree that the claims as pending are indefinite, Applicants have amended claims 68, 69 and 78 to recite to include such a determination step.

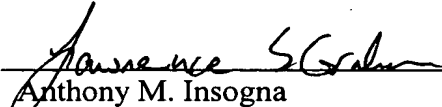
The indefiniteness rejection of Paper Nos. 19 and 34 are not relevant to claims 68, 69 and 78 as currently pending and as amended. In Paper No. 19, the Examiner contended claims 68 and 69 were “indefinite in their recitation of ‘measuring the effect of the alteration on the death of the cell’ because it is unclear what type of measurement is being referred to.” Paper No. 19, page 7. Similarly, in Paper No. 34, the Examiner contended that claims 68, 69 and 78 were “indefinite in their recitation of ‘measuring the effect of the alteration on the death of the cell by measuring cell death’ because it is unclear what type of measurements are to be made to measure cell death.” Paper No. 34, page 5. These phrases quoted by the Examiner are not present in pending or amended claims 68, 69 or 78. Moreover, these claims as amended explicitly recite determining the *number* of cells that die; thus, it is clear what measurement is required. Applicants therefore submit that these claims as amended are definite, and request withdrawal of the rejection of claims 68, 69 and 78 on this basis.

### CONCLUSION

For the reasons set forth above, it is respectfully submitted that Applicants' claims as amended should proceed to allowance. No fee is believed due. However, if a fee is deemed to be required in connection with this paper, please charge Pennie & Edmonds Deposit Account Number 16-1150 for the appropriate amount.

Respectfully submitted,

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